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Technology Center 2100

Paper No. 27

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In re Application of: Pi-Wei Chin et al.)
Application No. 09/161,073)
Filed: September 25, 1998)
For: INTERFACE FOR PROVIDING)
DIFFERENT-LANGUAGE)
VERSIONS OF MARKUP-)
LANGUAGE RESOURCES)

**DECISION ON PETITION
UNDER 37 CFR § 1.181 TO
INVOKE SUPERVISORY
AUTHORITY**

This is a decision on the petition under 37 CFR 1.181, filed February 26, 2003 requesting the Group Director to enter an amendment which was refused entry in the Advisory action mailed on January 15, 2003.

The petition is **DISMISSED**.

CASE HISTORY

An Office action finally rejecting all claims pending in the above-referenced application was mailed on October 22, 2002. Applicant filed a proposed amendment after final (Paper No. 22) on December 27, 2002. The Examiner responded with an Advisory action mailed January 31, 2003 indicating that the proposed amendment after-final would not be entered because 1) it raises New Issues that would require further search and/or consideration, and 2) it did not place the case in better form for appeal by materially reducing or simplifying the issues for appeal.

Petitioner filed the instant petition on February 26, 2003, contending that the proposed amendment should have been entered and requesting withdrawal of the refusal to enter the proposed amendment.

RELIEF REQUESTED

The instant petition under 37 CFR § 1.181 requests the following relief:

Petitioners request that the refusal to enter the after final amendment (Paper No. 23) be withdrawn and that the amendment be sufficiently considered pursuant to MPEP 714.13 and 37 CFR § 1.116.

OPINION

The relevant section of the MPEP concerning entry of amendments after a final rejection is MPEP § 714.13 which states:

ENTRY NOT A MATTER OF RIGHT

It should be kept in mind that applicant cannot, as a matter of right, amend any finally rejected claims, add new claims after a final rejection (see 37 CFR 1.116) or reinstate previously canceled claims. Except where an amendment merely cancels claims, adopts examiner suggestions, removes issues for appeal, or in some other way *requires only a cursory review by the examiner*, compliance with the requirement of a showing under 37 CFR 1.116(b) is expected in all amendments after final rejection.

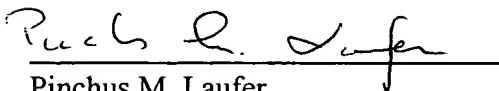
The newly proposed claims are *not equivalent to any previously presented claims*, but rather they comprise of a claim scope not previously presented. As set forth in the Advisory action, this is the result of applicant's amendment replacing "unambiguously" with "always", which changes the scope of the claimed invention. The deleted term, ("unambiguous") can be interpreted as clear and definite, whereas the amendatory language ("always") is interpreted as always occurring, regardless. Furthermore, it is unclear whether support exists for the amendment in Applicant's specification, raising the possibility of new matter rejection. Accordingly, said amendment would require further search and/or consideration.

As set forth above, the amendment clearly fails to simplify the issues, in fact, it raises new issues and would have required further search and/or consideration if entered. As such, the examiner acted properly and within his duties to deny entry of this amendment.

The examiner's refusal to enter the proposed amendment is correct and consistent with Office policy and practice. Accordingly, the Petition to compel the examiner to enter the amendment is **DISMISSED**.

The application file is being forwarded to the Examiner of record to consider Applicant's Brief on Appeal filed February 20, 2003.

Any request for reconsideration must be filed within two months of the mailing date of this decision.



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